No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF FOR RESPONDENT

STUART BANNER
EUGENE VOLOKH
UCLA School of Law
Supreme Court Clinic
405 Hilgard Ave.
Los Angeles, CA 90095

JOHN C. CONNELL
Counsel of Record
RONALD D. COLEMAN
JOEL G. MACMULL
Archer & Greiner, P.C.
One Centennial Square
P.O. Box 3000
Haddonfield, NJ 08033
(856) 795-2121
jconnell@archerlaw.com

QUESTIONS PRESENTED

The disparagement clause in section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), prohibits the registration of a trademark that "may disparage ... persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."

The Questions Presented are:

1. Whether the disparagement clause bars the registration of respondent's trademark.

2. Whether the disparagement clause is contrary to the First Amendment.

3. Whether the disparagement clause is unconstitutionally vague under the First and Fifth Amendments.

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STATEMENT

In the decision below, the en banc Court of Appeals correctly held that the disparagement clause of the Lanham Act is contrary to the First Amendment. This provision bars the registration of a trademark that "may disparage ... persons, living or dead." 15 U.S.C. § 1052(a). As the Court of Appeals found, the disparagement clause discriminates on the basis of viewpoint and content, by imposing a substantial burden on speech with a particular message. The government offers no justification for this discriminatory burden on speech other than its interest in preventing offense to listeners, but that is not a valid basis for restricting expression.

Certiorari should nevertheless be granted. This issue is undeniably important. The Court is very likely to address it in the near future, in another case if not in this one. Meanwhile, respondent Simon Tam waits in limbo. His trademark rights will not be secure until the Court resolves this issue once and for all.

1. Simon Tam is an Asian-American musician, lecturer, and political activist. He is the founder and leader of The Slants, a rock band based in Portland, Oregon. When Tam formed the band in 2006, his purpose was not just to play music. He also intended the band to be a vehicle for expressing his views on discrimination against Asian-Americans. To that end, he recruited Asian-American band members, and he called the band The Slants.

In choosing that name, Tam was following in the long tradition of "reappropriation," in which members of minority groups have reclaimed terms that were once directed at them as insults and turned them outward as badges of pride. In recent times, the most conspicuous examples have been words such as "queer," "dyke," and so on—formerly derogatory terms that have been so successfully adopted by members of the gay and lesbian community that they have now lost most, if not all, of their pejorative connotations. Members of several other groups have pursued the same strategy. As Randall Kennedy observes:

> Many blacks also do with *nigger* what other members of marginalized groups have done with slurs aimed at shaming them. They have thrown the slur right back in their oppressors' faces. They have added a positive meaning to *nigger*, just as women, gays, lesbians, poor whites, and children born out of wedlock have defiantly appropriated and revalued such words as *bitch*, *cunt*, *queer*, *dyke*, *redneck*, *cracker*, and *bastard*.

Randall Kennedy, *Nigger: The Strange Career of a Troublesome Word* 48 (2002).[1]

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[1] Before the PTO, Tam did not characterize his use of the name as reappropriation, because TTAB precedent foreclosed the argument that reappropriation of a term can render a mark non-disparaging. *See In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114 (TTAB 2008). The TTAB nevertheless recognized that Tam's use of the name was "an attempt ... to wrest 'ownership' of the term from those who might use it with the intent to disparage." Pet. App. 175a. The Court of Appeals

Tam aimed to do the same for Asian-Americans. "We want to take on these stereotypes that people have about us, like the slanted eyes, and own them," he explained. Fed. Cir. JA 4. He observed: "For our band, we're not just Chinese, we're not just Vietnamese, we're kind of a pan-Asian band that celebrates all the different Asian cultures out there .... Everyone in the band really loves the fact that we can try and empower Asian Americans and say, 'You know what? We are slanted. Who cares? We're proud of that.'" Fed. Cir. JA 45.

In their music, as the Court of Appeals found, "Mr. Tam and his band weigh in on cultural and political discussions about race and society." Pet. App. 10a. Sometimes that takes the form of wry commentary. The Slants' first album is called "Slanted Eyes, Slanted Hearts." Their fourth is "The Yellow Album," a title that combines references to the Beatles' 1968 "White Album" and Jay-Z's 2003 "Black Album" with a reference to the once-common use of the color yellow to refer pejoratively to Asians, as in the phrase "Yellow Peril."

At other times, The Slants come closer to straightforward advocacy. For example, the chorus of their song "Sakura, Sakura" is:

> We sing for the Japanese and the Chinese and
> all the dirty knees.

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likewise recognized that Tam "seeks to shift the meaning of, and thereby reclaim, an emotionally charged word." Pet. App. 24a.

> Can you see me? We sing in harmony for the babies in the alleys.

The title of "Sakura, Sakura" refers to the well-known Japanese folk song of the same name ("sakura" is Japanese for "cherry blossom"). The Slants' song incorporates part of the melody of the folk song. The first line of the chorus recalls a schoolyard taunt familiar to many Asian-Americans—"Chinese, Japanese, dirty knees, look at these." As Tam has explained, The Slants "feel strongly that Asians should be proud of their cultural heritage, and not be offended by stereotypical descriptions." Pet. App. 10a (brackets omitted).

In 2011, Tam sought to register THE SLANTS as a trademark. Pet. App. 10a. The examiner refused to register the mark, on the ground that it is disparaging to "persons of Asian descent." Pet. App. 10a.

2. The Trademark Trial and Appeal Board affirmed. Pet. App. 162a-182a. The Board acknowledged that Tam's purpose in naming his band The Slants was "an attempt not to disparage, but rather to wrest 'ownership' of the term from those who might use it with the intent to disparage." Pet. App. 175a. The Board nevertheless determined that "[t]he evidence of public perception of the meaning of THE SLANTS, as used in connection with applicant's services, shows that meaning to be a derogatory reference to people of Asian descent." Pet. App. 174a. The Board concluded that "[t]he fact that applicant has good intentions underlying his use of the term does not obviate the fact that a substantial composite of

the referenced group find the term objectionable." Pet. App. 181a.

Tam appealed to the Court of Appeals for the Federal Circuit. He argued that the Board erred in finding his trademark unregistrable under section 2(a) of the Lanham Act, and that section 2(a)'s disparagement clause is contrary to the First Amendment and unconstitutionally vague.

3. A panel of the Court of Appeals affirmed. Pet. App. 123a-161a. The Court of Appeals found that "[t]he evidence here supports the Board's finding that the mark THE SLANTS likely refers to people of Asian descent." Pet. App. 128a. The court also found that "[s]ubstantial evidence supports the Board's finding that the mark THE SLANTS is likely offensive to a substantial composite of people of Asian descent." Pet. App. 130a. The Court of Appeals relied on the precedent of its predecessor court, the Court of Customs and Patent Appeals, to reject Tam's constitutional arguments. Pet. App. 131a-132a (citing *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981)).

Judge Moore wrote a separate opinion urging the Court of Appeals to reconsider the constitutionality of section 2(a)'s disparagement clause. Pet. App. 135a-161a (Moore, J., additional views).

4. The en banc Court of Appeals vacated the Board's decision and remanded the case to the Board for further proceedings. Pet. App. 1a-122a. The court began by observing that "Mr. Simon Shiao Tam named his band THE SLANTS to make a statement about racial and cultural issues in this country. With

his band name, Mr. Tam conveys more about our society than many volumes of undisputedly protected speech." Pet. App. 2a. The en banc court reinstated the panel's holding that the name is "disparaging" and is thus unregistrable under section 2(a). Pet. App. 12a n.3. But the en banc court held that section 2(a)'s disparagement clause is contrary to the First Amendment.

The Court of Appeals concluded that the disparagement clause discriminates on the basis of viewpoint and content. As the court observed, "[t]he PTO rejects marks under § 2(a) when it finds the marks refer to a group in a negative way, but it permits the registration of marks that refer to a group in a positive, non-disparaging manner." Pet. App. 21a. The court concluded: "Section 2(a) is a viewpoint-discriminatory regulation of speech, created and applied in order to stifle the use of certain disfavored messages. Strict scrutiny therefore governs its First Amendment assessment—and no argument has been made that the measure survives such scrutiny." Pet. App. 23a-24a.

The Court of Appeals further held that the disparagement clause could not be upheld as a regulation of commercial speech. The court noted that the disparagement clause regulates the expressive aspects of a trademark, not the mark's commercial function as the identifier of the source of a good or service. Pet. App. 24a. "Importantly," the court noted, "*every time* the PTO refuses to register a mark under § 2(a), it does so because it believes the mark conveys an expressive message—a message that is disparaging to certain groups." Pet. App. 25a. The

court observed that the First Amendment does not permit content-based regulation of commercial speech where the discrimination is based on the speech's expressive features. Pet. App. 25a-26a.

The Court of Appeals rejected the government's contention that section 2(a) restricts no speech and is thus immune from First Amendment scrutiny. Pet. App. 28a-40a. The court observed that the First Amendment prohibits content-based and viewpoint-based *burdens* on speech, just as it prohibits similarly discriminatory *bans* on speech. Pet. App. 28a-30a. The court recognized that the legal advantages of trademark registration are so significant that "the § 2(a) bar on registration creates a strong disincentive to choose a 'disparaging' mark." Pet. App. 32a.

The Court of Appeals also rejected the government's suggestion that trademarks should receive no First Amendment protection on the theory that trademark registrations are government speech. Pet. App. 40a-47a. The court held that registration does not change the fact that trademarks are private speech, not government speech. Pet. App. 40a-41a. The court further held that the accoutrements of registration, such as the registrant's right to use the ® symbol, the placement of the mark on the Principal Register, and the PTO's issuance of a registration certificate, "do not convert the underlying speech to government speech." Pet. App. 41a. As the court noted, "the PTO routinely registers marks that no one can say the government endorses," such as CAPITALISM SUCKS DONKEY BALLS and MURDER 4 HIRE. Pet. App. 43a. The court observed, moreover, that "[c]opyright registration has identical accoutre-

ments," so the government's theory would allow it to deny copyrights to works that disparaged others, an outcome that would clearly violate the First Amendment. Pet. App. 41a.

The Court of Appeals likewise rejected, on two grounds, the government's argument that section 2(a) is a government subsidy exempt from strict scrutiny. Pet. App. 47a-61a. First, the court noted that under the unconstitutional conditions doctrine, the government may not attach "'conditions that seek to leverage funding to regulate speech outside the contours of the program itself.'" Pet. App. 51a (quoting *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013)). Because trademark registration "is not a program through which the government is seeking to get its message out through recipients of funding," the court held, the government cannot condition trademark registration on the avoidance of a particular viewpoint. Pet. App. 52a.

Second, the Court of Appeals determined that trademark registration is not a subsidy. Pet. App. 52a-61a. As the court noted, "the subsidy cases have all involved government funding or government property." Pet. App. 53a. Trademark registration, by contrast, involves neither. "Unlike a subsidy consisting of, for example, HIV/AIDS funding, or tax exemptions, a trademark registration does not directly affect the public fisc," the court concluded. "Instead, a registered trademark redefines the nature of the markholder's rights as against the rights of other citizens." Pet. App. 57a. Thus "the system of trademark

registration is a regulatory regime, not a government subsidy program." Pet. App. 57a.

Finally, the Court of Appeals held that section 2(a)'s bar on disparaging trademarks would be contrary to the First Amendment even if it were classified as a regulation of commercial speech. Pet. App. 61a-67a. Under the intermediate scrutiny applicable to commercial speech, regulation must advance a substantial government interest, but the court found that "§ 2(a) immediately fails at this step," because "[t]he entire interest of the government in § 2(a) depends on disapproval of the message." Pet. App. 63a.

Judge O'Malley, joined by Judge Wallach, filed a concurring opinion. Pet. App. 68a-80a. She agreed that section 2(a)'s disparagement clause is contrary to the First Amendment. She also concluded that the disparagement clause is unconstitutionally vague.

Judge Dyk filed an opinion concurring in part and dissenting in part, which Judges Lourie and Reyna joined in part. Pet. App. 80a-104a. He concluded that section 2(a)'s disparagement clause is contrary to the First Amendment only as applied to marks, such as Simon Tam's, that are "both political and commercial." Pet. App. 102a. He would have upheld the clause as applied to "routine product identifiers," Pet. App. 89a, which he characterized as trademarks that "lack the kind of 'expressive character' that would merit First Amendment protection for offensive content." Pet. App. 90a.

Judge Lourie dissented. Pet. App. 104a-108a. In his view, the PTO's refusal to register a trademark "is not a denial of an applicant's right of free speech,"

because "Mr. Tam may use his trademark as he likes" even without federal registration. Pet. App. 105a.

Judge Reyna also dissented. Pet. App. 108a-122a. He concluded that trademarks are commercial speech and that section 2(a)'s disparagement clause satisfies the intermediate scrutiny applicable to commercial speech, in light of the "the government's substantial interest in the orderly flow of commerce." Pet. App. 119a.

ARGUMENT

The government's petition for certiorari should be granted, but the Questions Presented should be reformulated to reflect the issues in this case.

I. Certiorari should be granted.

The decision below is correct. The Court should nevertheless grant the petition for certiorari, for three reasons.

First, the issue is undeniably important. The Court of Appeals has invalidated a provision of the Lanham Act, a statute that plays a major role in regulating commerce. The constitutionality of section 2(a)'s disparagement clause is likely to return to the Court repeatedly in future cases until the Court puts the issue to rest.

Second, although Simon Tam prevailed in the Court of Appeals, his trademark rights will not be secure until this Court decides the issue once and for all. If the Court denies certiorari in this case, even if the PTO registers Tam's trademark, his registration

will be precarious, because of the possibility that the decision below will be overruled by this Court in a future case.

One such case has already reached the Court. The Washington Redskins have filed a petition for certiorari before judgment in a case that raises the same First Amendment and vagueness issues as does this case. Pet. for Cert., *Pro-Football, Inc. v. Blackhorse*, No. 15-1311 (filed Apr. 25, 2016). If the Court wishes to hear the two cases together, we urge the Court to do so now rather than waiting until the Fourth Circuit has decided the Redskins' case. It has already been five years since Simon Tam filed his trademark application. The PTO has halted the processing of all trademark applications raising disparagement issues, including Tam's, until the Court disposes of the government's certiorari petition in this case. Pet. 23. The Fourth Circuit has not yet held oral argument, so there may be no resolution of the Redskins' case for a year or more, particularly if the Fourth Circuit takes the case en banc. The Court should not hold this case for the Redskins' case.

Third, this case is an excellent vehicle. Simon Tam's trademark undisputedly has an expressive component along with a commercial component, so the Court will be able to evaluate the First Amendment's applicability to the full range of conceivable types of trademarks.

Moreover, this case involves two other important issues that are not captured by the government's unduly narrow Question Presented.

The first of these issues is one of statutory interpretation. Under section 2(a) of the Lanham Act, does THE SLANTS "disparage ... persons, living or dead"? At every stage of this litigation, Simon Tam has argued that section 2(a) does not bar the registration of his trademark. He is thus entitled to defend the judgment below on this ground. *14 Penn Plaza LLC v. Pyett*, 556 U.S. 247, 273 (2009). Even if that were not so, "it is a well-established principle governing the prudent exercise of this Court's jurisdiction that normally the Court will not decide a constitutional question if there is some other ground upon which to dispose of the case." *Bond v. United States*, 134 S. Ct. 2077, 2087 (2014) (citation and internal quotation marks omitted). A proper interpretation of section 2(a) is such a ground.

Section 2(a)'s disparagement clause has existed for 70 years, but the Court has never interpreted it. The PTO has been left to develop its own disparagement jurisprudence, which has wandered ever farther from the statute's text and from any reasonable understanding of what Congress intended. This case provides an opportunity for the Court to guide the PTO back to the text of the statute.

The second issue not captured by the government's Question Presented is whether section 2(a)'s disparagement clause is unconstitutionally vague. Simon Tam raised this issue below as well, so he is entitled to defend the Court of Appeals' judgment on this ground.

This is another issue the Court has never considered in the 70 years since the disparagement clause

was enacted. The PTO, left to its own devices, has produced a bewildering array of decisions granting or denying registration seemingly at random. As the Court of Appeals found, "[t]he PTO's record of trademark registrations and denials often appears arbitrary and is rife with inconsistency.... We see no rationale for the PTO's seemingly arbitrary registration decisions, let alone one that would give applicants much guidance." Pet. App. 33a n.7. As the two concurring judges found, the disparagement clause is "so vague that [it is] unconstitutional, whether or not it could survive Appellant's First Amendment challenge." Pet. App. 69a (O'Malley, J., concurring). It is time for this Court to intervene.

II. The judgment of the Court of Appeals should be affirmed.

The judgment below should be affirmed, on any of three grounds. First, as a matter of statutory construction, respondent's trademark does not "disparage ... persons, living or dead" under section 2(a). Second, the disparagement clause is contrary to the First Amendment. Third, the disparagement clause is unconstitutionally vague under the First and Fifth Amendments.

A. The Lanham Act's disparagement clause does not bar the registration of respondent's trademark.

Section 2(a)'s disparagement clause prohibits the registration of a trademark that "[c]onsists of or comprises ... matter which may disparage ... persons, living or dead, institutions, beliefs, or national

symbols, or bring them into contempt, or disrepute." 15 U.S.C. § 1052(a). This clause does not bar registration of THE SLANTS, for two reasons. First, the mark is simply not disparaging. Second, the statutory phrase "persons, living or dead" refers solely to natural and juristic persons, not to non-juristic collective entities like racial or ethnic groups.

1. THE SLANTS, as used by Simon Tam to refer to his band, is not disparaging. Whether a word is disparaging depends primarily on context. Even "nigger" and its variants are not disparaging when used with pride and understood that way. For example, one of the most well-known and influential musical groups of the 1980s and 1990s was N.W.A., which fans knew stood for "Niggaz Wit Attitudes." (Anyone who did not know would have figured it out when the group released their second album, *Niggaz4Life*.) "Niggers" or "niggaz" can certainly be used in a disparaging way, but the members of N.W.A. did not use the word that way, and the group's millions of fans did not interpret the name as disparaging.

The same is true of The Slants. Simon Tam and his band members are not disparaging Asian-Americans. They are doing precisely the opposite; they are appropriating a slur and using it as a badge of pride. Simon Tam is not a bigot; he is fighting bigotry with the time-honored technique of seizing the bigots' own language. "Slant" can certainly be used in a disparaging way, but Tam is not using it that way. Even the most cursory awareness of the Slants' music and the way it is packaged makes that clear.

Nor do the Slants' fans think the band's name is disparaging. The Slants' fans are not racists eager to denigrate Asian-Americans. They are people who understand and appreciate what the Slants are doing. They get it. Only an uninformed philistine could find the band's name disparaging.

If the PTO interpreted the statute literally, with a dose of common sense, that would be enough to find that THE SLANTS does not "disparage" anyone. But rather than interpreting the statute literally, the PTO uses a two-part test that departs markedly from the text of the statute. To determine whether matter in a proposed trademark is disparaging, the PTO considers:

> 1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
>
> 2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

Pet. App. 171a-172a. This test has been endorsed by the Federal Circuit. Pet. App. 126a.

Both parts of the PTO's test contort the word "disparage" far beyond what the statute will bear. The

first part of the test tells examiners to rely on dictionary definitions of a word used in a trademark, but not to consider any of the contextual considerations that make up the ordinary meaning of the word "disparage," such as whether the applicant intends any disparagement, whether the applicant's customers perceive any disparagement, or whether an objective observer knowing the full context would find any disparagement. But the statute does not say "disparage, with reference solely to dictionary definitions and not context." The statute just says "disparage."

The second part of the test tells examiners to determine whether the mark "may be disparaging to a substantial composite of the referenced group." The PTO interprets "substantial composite" to mean "not necessarily a majority," but with no limit on how small a percentage of the referenced group is offended. Pet. App. 172a. Examiners are thus instructed to determine whether a mark disparages a vocal *minority* of a group, not whether the mark disparages the affected group generally.

In this case the PTO duly applied its test. Rather than considering the full context surrounding Simon Tam's use of THE SLANTS, the PTO simply looked up the word "slant" in several dictionaries. Pet. App. 163a-165a. Rather than asking whether THE SLANTS disparages Asian-Americans generally, the PTO quoted the views of a blogger and a few self-styled spokespeople for Asian-Americans, Pet. App. 167a-168a, to conclude that "a substantial composite of the referenced group find the term objectionable." Pet. App. 181a. Had the PTO followed the statute

rather than its two-part test, the result would have been different.

2. The PTO also erred in construing section 2(a)'s bar on the registration of marks that may disparage "persons, living or dead" to include marks that disparage non-juristic collective entities like racial and ethnic groups. In fact, the quoted phrase includes only natural and juristic persons.

"Person" is a defined term in the Lanham Act. Under section 45, "[t]he term 'person' ... includes a juristic person as well as a natural person. The term 'juristic person' includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law." 15 U.S.C. § 1127. Non-juristic collective entities incapable of suing and being sued, such as racial and ethnic groups, are not "persons" under this definition. Yet the PTO treats such groups as "persons" under the disparagement clause. *See, e.g., Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q.2d 1600, 1999 WL 1040108, *5 (TTAB 1999).

The PTO is misinterpreting the statute. Section 2(a)'s disparagement clause bars the registration of marks—such as JOHN SMITH IS EVIL—that disparage *natural* persons. It also bars the registration of marks—such as MICROSOFT IS EVIL—that disparage *juristic* persons. But the disparagement clause explicitly does *not* bar the registration of marks that disparage collective entities that are not juristic persons. Thus one can register LEFTHANDERS ARE EVIL or REDHEADS ARE EVIL or even ASIAN-AMERICANS ARE

EVIL without running afoul of section 2(a)'s disparagement clause.

To be sure, each individual Asian-American is a natural person. But the statute cannot be read to bar marks that disparage Asian-Americans for this reason, because *all* collective entities are made up of natural persons, including lefthanders, redheads, and all manner of associations and organizations that are not "juristic person[s]" because they are not capable of suing and being sued. To read section 2(a) to bar marks that disparage racial or ethnic groups would be to read the definition of "person" right out of the Lanham Act.

This conclusion is doubly reinforced by the text of the sentence in which the disparagement clause is located. First, this sentence bars the registration of marks consisting of "matter which may disparage *or falsely suggest a connection with* persons, living or dead." 15 U.S.C. § 1052(a) (emphasis added). The italicized phrase makes perfect sense as applied to natural persons. It prohibits the registration of BARACK OBAMA aftershave, along the lines of the right of publicity, which was still in embryonic form when the Lanham Act was enacted. The italicized phrase also makes perfect sense as applied to juristic persons. It prohibits the registration of ROLLS-ROYCE aftershave, along the lines of the anti-dilution provisions that would later be added to the Lanham Act. But the italicized phrase makes no sense at all as applied to collective entities such as racial or ethnic groups that are not juristic persons. What would it even mean to "falsely suggest a connection with" Asian-Americans?

Second, the clause refers to "persons, living or dead." *Id.* Natural persons can be dead, and juristic persons can be dead when they cease to be juristic persons, as when a corporation is dissolved. But non-juristic collective entities cannot die in the ordinary meaning of the word. What would it mean for the entity called Asian-Americans to be "dead"?

The addition of the disparagement clause to federal trademark law was not intended to be an early step in the civil rights movement. The clause was added in 1939 to one of the bills that eventually became the Lanham Act in 1946. H.R. 4744, 76th Cong., 1st Sess. (1939), § 2(a). It is very unlikely that members of Congress were concerned about trademarks that were disparaging to racial or ethnic groups, either in 1939 or in 1946. At the time, it was not unusual for registered trademarks to include pejorative racial epithets. Trademarks with registrations in effect during this period included NIGGER HEAD golf equipment (No. 221,097, registered in 1926 for a 20-year term), NIGGER PRIZE HEAD ice cream (No. 301,747, registered in 1933 for a 20-year term), NIGGER IN DE CANE PATCH syrup (No. 186,950, registered in 1924 for a 20-year term and renewed in 1944 for another 20-year term), and NIGGER BABY oranges and grapefruit (No. 217,067, registered in 1926 for a 20-year term and renewed in 1946 for another 20-year term).[2] There is no evidence that the disparagement clause was intended to halt the registration of such trademarks. Rather, when the clause

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[2] These trademarks are exhibits 7 through 10 in the appendix to the brief filed below in the Federal Circuit by amici Amanda Blackhorse et al.

was discussed in Congress, the only examples of disparagement anyone mentioned concerned natural persons (such as Abraham Lincoln and George Washington) and juristic persons (including the New York Athletic Club and Harvard University). *Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents*, 76th Cong., 1st Sess. 19-21 (1939).

The purpose of the disparagement clause was not to protect the civil rights of racial and ethnic minorities. Rather, the purpose appears to have been to bring American trademark law into conformity with the language of a recent treaty. In 1931, the United States ratified the Inter-American Convention for Trade Mark and Commercial Protection. 46 Stat. 2907 (1931). Article 3.4 of the Convention provided for the denial of registration to trademarks "[w]hich tend to expose persons, institutions, beliefs, national symbols or those of associations of public interest, to ridicule or contempt." One of the primary purposes of the Lanham Act was, as the House and Senate reports both explained, "[t]o carry out by statute our international commitments." H.R. Rep. No. 219, 79th Cong., 1st Sess. 4 (1945); S. Rep. No. 1333, 79th Cong., 2d Sess. 5 (1946). Indeed, the full title of the Lanham Act was "An Act to provide for the registration and protection of trade-marks used in commerce, to carry out the provisions of certain international conventions, and for other purposes." 60 Stat. 427 (1946). Section 2(a) slightly reworded the Inter-American Convention provision without any loss in meaning. It barred the registration of marks that "disparage" or "bring ... into contempt, or disrepute"

(rather than "expose ... to ridicule or contempt") the same list of plural nouns as in the Convention—persons, institutions, beliefs, and national symbols.

Congress would not turn its attention to protecting the rights of racial and ethnic minorities for many years to come. When it did, beginning with the Civil Rights Act of 1957, Congress would refer to race and ethnicity explicitly, unlike in the Lanham Act. Section 2(a) thus protects natural and juristic persons against disparagement; it does not protect racial and ethnic groups.

B. The Lanham Act's disparagement clause is contrary to the First Amendment.

The Court of Appeals correctly held that section 2(a)'s disparagement clause is contrary to the First Amendment. The clause imposes a significant content-based and viewpoint-based burden on speech for which the government can offer no lawful justification. The government proposes a variety of defenses of the disparagement clause, but none has any validity.

1. The disparagement clause discriminates on the basis of content, by singling out disparaging marks for disfavored treatment. The clause also discriminates on the basis of viewpoint, which is an "all the more blatant" and "egregious form of content discrimination." *Rosenberger v. Rector and Visitors of the Univ. of Va.*, 515 U.S. 819, 829 (1995). The disparagement clause permits the registration of marks that express a positive or neutral view of a person or

group, but bars the registration of marks that express a negative view. Applying the disparagement clause, the PTO has registered THINK ISLAM, but it has denied registration to STOP THE ISLAMISATION OF AMERICA. Pet. App. 21a-22a. The PTO has registered NATIONAL REPUBLICAN SENATORIAL COMMITTEE, but it has denied registration to REPUBLICANS SHOULDN'T BREED. Pet. App. 8a. The PTO has registered CELEBRASIANS and ASIAN EFFICIENCY, Pet. App. 21a, but—because it erroneously concluded that the mark expresses a negative view of Asian-Americans—the PTO denied registration to THE SLANTS.

The denial of registration is a significant blow, because a registered trademark is much more valuable than an unregistered trademark. As the Court has repeatedly recognized, "[r]egistration is significant. The Lanham Act confers important legal rights and benefits on trademark owners who register their marks." *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1300 (2015) (citation and internal quotation marks omitted); *see also KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117 (2004); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209 (2000). For example, registration serves as nationwide constructive notice of the registrant's claim of ownership, which eliminates any possible defense of good faith adoption after the date of registration. 15 U.S.C. § 1072. Registration constitutes prima facie evidence of the mark's validity and the registrant's exclusive right to use the mark. *Id.* §§ 1057(b), 1115(a). After five

years, a registered mark can become "incontestable." *Id.* §§ 1065, 1115(b).

The advantages of registration are as great in the music industry as in any other business. If another band were also to call themselves The Slants, registration would equip Tam with powerful tools in the event of litigation. These tools would likely be enough to deter other bands from calling themselves The Slants in the first place. For this reason, bands from ABBA to ZZ TOP routinely register their names as trademarks, and guides for musicians advise up-and-coming bands to do the same. *See, e.g.*, Richard Stim, *Music Law: How to Run Your Band's Business* 249, 259 (8th ed. 2015); Donald S. Passman, *All You Need to Know About the Music Business* 359-60 (8th ed. 2012).

Section 2(a)'s disparagement clause imposes a significant burden on speech with a particular content and viewpoint. It is thus "presumptively unconstitutional and may be justified only if the government can prove that [it is] narrowly tailored to serve compelling state interests." *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015).

The only interest the government asserts, and the only interest the disparagement clause advances, is that of protecting people from being offended by disparaging trademarks. *See, e.g.*, Pet. 21 (quoting Judge Dyk's characterization of the government's interest as "protect[ing] underrepresented groups in our society from being bombarded with demeaning messages in commercial advertising"). But the First Amendment does not allow the government to im-

pose burdens on speech for the purpose of protecting listeners against offense. *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 55 (1988). "[S]peech cannot be restricted simply because it is upsetting." *Snyder v. Phelps*, 562 U.S. 443, 458 (2011). "Speech cannot be financially burdened, any more than it can be punished or banned, simply because it might offend." *Forsyth Cty. v. Nationalist Movement*, 505 U.S. 123, 134-35 (1992).

Nor does the First Amendment permit the government to burden speech to protect society as a whole from being offended. Disparaging trademarks understandably arouse disgust, "but disgust is not a valid basis for restricting expression." *Brown v. Entertainment Merchants Ass'n*, 564 U.S. 786, 798 (2011). "If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." *Texas v. Johnson*, 491 U.S. 397, 414 (1989). Commercial speech is no more restrictable based on its offensive message than is noncommercial speech, *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71-72 (1983); *Carey v. Population Servs., Int'l*, 431 U.S. 678, 701 (1977), so the government's asserted interest would be impermissible even if trademarks were purely commercial speech.

2. The government offers four theories in defense of the disparagement clause, but none has any validity.

First, the government insists that the disparagement clause does not restrict any speech, because

Simon Tam may still call his band The Slants without a registered trademark. Pet. 10-12. But the First Amendment does not prohibit merely content-based *bans* on speech. It also prohibits the imposition of "a financial burden on speakers because of the content of their speech." *Simon & Schuster, Inc. v. Members of the N.Y. Crime Victims Bd.*, 502 U.S. 105, 115 (1991). As the Court has explained on several occasions, "the government's ability to impose content-based burdens on speech raises the specter that the government may effectively drive certain ideas or viewpoints from the marketplace." *Id.* at 116 (citing *Leathers v. Medlock*, 499 U.S. 439, 448-49 (1991)). "The Court has recognized that the 'distinction between laws burdening and laws banning speech is but a matter of degree' and that the 'Government's content-based burdens must satisfy the same rigorous scrutiny as its content-based bans.'" *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 565-66 (2011) (quoting *United States v. Playboy Entertainment Group, Inc.*, 529 U.S. 803, 812 (2000)).

The disparagement clause is a significant content-based burden. The advantages of trademark registration are so important in the marketplace that no rational person would use a trademark that cannot be registered rather than one that can. The disparagement clause effectively discourages the adoption of certain trademarks, just as surely as would a tax levied on businesses with disparaging names.

Second, the government characterizes trademark registration as a subsidy to trademark owners which the government may spend as it sees fit. Pet. 14-17. But trademark registration is not a subsidy. Money

flows from applicants to the government, not the other way around. In contrast, the Court's subsidy cases all involve actual disbursements of funds from the government to speakers (or the equivalent in the form of tax exemptions or payroll deductions). *See, e.g.*, *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321 (2013); *Ysursa v. Pocatello Educ. Ass'n*, 555 U.S. 353 (2009); *Davenport v. Washington Educ. Ass'n*, 551 U.S. 177 (2007); *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533 (2001); *NEA v. Finley*, 524 U.S. 569 (1998); *Rust v. Sullivan*, 500 U.S. 173 (1991); *Regan v. Taxation With Representation of Wash.*, 461 U.S. 540 (1983). Where the government is paying others to speak, it may choose whom to pay. But trademark registration does not involve any government payments to speakers.

Rather, trademark registration is a recording system, analogous to the federal registration systems for copyrights and patents, and like the title recording systems state governments operate for real property. In each of these systems, applicants who meet certain requirements may register their property, and registration gives the registrant certain legal rights that are unavailable to non-registrants. The government is acting as a regulator, not as a subsidizer. Just as the federal government does not subsidize copyright or patent holders, and just as state governments do not subsidize landowners who register their titles, the PTO does not subsidize trademark registrants. Classifying these recording systems as subsidies for First Amendment purposes would yield the bizarre result of allowing the gov-

ernment to deny copyrights to works with messages the government does not like.

In any event, the disparagement clause would be unconstitutional even if trademark registration were a subsidy. The government may not "leverage its power to award subsidies ... into a penalty on disfavored viewpoints." *Finley*, 524 U.S. at 587. When the government places speech-related conditions on the recipients of government funds, those conditions must "define the limits of the government spending program"—i.e., the conditions must advance "the activities Congress wants to subsidize." *AID*, 133 S. Ct. at 2328. Were the government to begin subsidizing trademark registrants, the First Amendment would thus allow the government to deny subsidies to registrants whose marks do a poor job of identifying the sources of goods or services. But the government could not deny these subsidies to registrants whose marks express disfavored viewpoints.

Third, the government suggests that a registered trademark is government speech rather than private speech. Pet. 17-20. But registration of a trademark does not convert the trademark into government speech. Registration does not connote government approval of the mark or the product to which the mark refers. 3 *McCarthy on Trademarks and Unfair Competition* § 19:3.50 (4th ed. Westlaw). Unlike license plates, *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2248 (2015), trademarks do not communicate messages from the government. They communicate messages from providers of goods and services. Unlike license plates, *id.* at 2248-49, trademarks are not a form of govern-

ment ID the public thinks of as government speech. Unlike license plates, *id.* at 2249, the government does not control the design or the content of trademarks. Trademarks are private speech.

As the Court of Appeals correctly noted, "the PTO routinely registers marks that no one can say the government endorses," such as RADICALLY FOLLOWING CHRIST IN MISSION TOGETHER, THINK ISLAM, GANJA UNIVERSITY, CAPITALISM SUCKS DONKEY BALLS, TAKE YO PANTIES OFF, and MURDER 4 HIRE. Pet. App. 43a. Moreover, if the issuance of a trademark registration were enough to convert a trademark to government speech, the issuance of a copyright would do the same for copyrighted works, which would allow the government to deny copyrights to works with content it disfavors.

Fourth, the government contends that trademarks are purely commercial speech. Pet. 20-21. But trademarks are not purely commercial speech, and the disparagement clause would be unconstitutional even if they were.

Trademarks have both commercial and expressive functions. They identify the sources of goods and services and they also express points of view. In some trademarks, perhaps, the expressive component may be so minimal that it can be disregarded. *Friedman v. Rogers*, 440 U.S. 1 (1979), for instance, involved a bare-bones trade name ("Texas State Optical") that did not "editorialize on any subject, cultural, philosophical, or political," or "make generalized observations even about commercial matters." *Id.* at 11. The Court accordingly treated this trade

name as commercial speech. *Id.* In other trademarks, such as THE SLANTS, THINK ISLAM, or DYKES ON BIKES, the expressive component is the dominant feature of the mark. Such marks *do* editorialize on cultural and political subjects. They do more than merely facilitate commercial transactions. In such cases, where speech's commercial and expressive functions "are inextricably intertwined, we cannot parcel out the speech, applying one test to one phrase and another test to another phrase. ... Therefore, we apply our test for fully protected expression." *Riley v. Nat'l Fed'n of the Blind*, 487 U.S. 781, 796 (1988).

Equally important, the disparagement clause regulates only the expressive component of trademarks, never the commercial component. When the PTO refuses registration under the disparagement clause, the PTO's decision is based on the point of view that the mark expresses. As the Court of Appeals correctly concluded, "*every time* the PTO refuses to register a mark under § 2(a), it does so because it believes the mark conveys an expressive message—a message that is disparaging to certain groups." Pet. App. 25a. The Court has made clear that "[c]ommercial speech is no exception" to the rule that "[t]he First Amendment requires heightened scrutiny whenever the government creates a regulation of speech because of disagreement with the message it conveys." *Sorrell*, 564 U.S. at 566 (internal quotation marks omitted). While the government may limit commercial advertising to prevent fraud, the government "may not prohibit only that commercial advertising

that depicts men in a demeaning fashion." *R.A.V. v. City of St. Paul*, 505 U.S. 377, 389 (1992).

In any event, even if trademarks were pure commercial speech, and even if the disparagement clause regulated trademarks' commercial components rather than their expressive components, the disparagement clause would still be contrary to the First Amendment. Under the *Central Hudson* test, the government would have to show that the disparagement clause directly advances a substantial state interest. *Thompson v. Western States Med. Ctr.*, 535 U.S. 357, 367 (2002); *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557, 566 (1980). Again, however, the government can advance no interest other than that of preventing offense, an interest the First Amendment renders off-limits.

C. The Lanham Act's disparagement clause is unconstitutionally vague.

The Due Process Clause "requires the invalidation of laws that are impermissibly vague." *FCC v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012). The prohibition of vague laws serves two purposes: "first, that regulated parties should know what is required of them so they may act accordingly; second, precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory way." *Id.* "When speech is involved, rigorous adherence to these requirements is necessary to ensure that ambiguity does not chill protected speech." *Id.* For this reason, where a law burdens speech, "a more stringent vagueness test

should apply." *Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 499 (1982).

The disparagement clause fails any vagueness test, stringent or not. The PTO's record speaks for itself. The Court of Appeals catalogued some of the highlights, in finding that "[t]he PTO's record of trademark registrations and denials often appears arbitrary and is rife with inconsistency." Pet. App. 33a n.7. The PTO denied registration to HAVE YOU HEARD SATAN IS A REPUBLICAN, because it disparaged the Republican Party, but did not find THE DEVIL IS A DEMOCRAT disparaging. The PTO has registered FAGDOG on some occasions, and on other occasions has found FAGDOG disparaging. After citing these examples and others, the Court of Appeals appropriately concluded: "We see no rationale for the PTO's seemingly arbitrary registration decisions, let alone one that would give applicants much guidance." Pet. App. 33a n.7.

Part of the problem is the subjectivity inherent in deciding whether a word is disparaging. Different examiners in the PTO come to different conclusions about indistinguishable marks, because each has his or her own idea of what is disparaging. Just as the term "annoying" is an unconstitutionally vague basis for legal consequences because different people find different things annoying, *Coates v. City of Cincinnati*, 402 U.S. 611, 614 (1971), and just as "indecent" and "patently offensive" are unconstitutionally vague grounds for limiting speech because of "uncertainty among speakers about ... just what they mean," *Reno v. ACLU*, 521 U.S. 844, 871 (1997), the term "disparage" is too vague a basis for burdening speech.

But the PTO has made the vagueness problem even worse by construing the statute non-literally to bar the registration of marks that disparage amorphous groups as well as natural and juristic persons. It can be hard enough to tell whether a mark disparages an individual or a company, but it is often far more ambiguous whether a mark disparages a race, or a gender, or any of the infinite number of groups to which we all belong. It is no accident that the PTO's sorry record of inconsistency is made up of decisions involving the disparagement of amorphous groups rather than natural and juristic persons.

The PTO has compounded the problem by refusing to say how many members of the referenced group must perceive disparagement. All the PTO will say is that it must be "a substantial composite," which is "not necessarily a majority," Pet. App. 172a, but is presumably more than a single person. If a quarter or a third of the members of a group find a mark disparaging, is that a substantial composite? No one knows, not even the PTO's own examiners.

The PTO might as well be tossing a coin. The PTO granted registration to HEEB in 2004 as the name of a magazine, but denied registration to the same applicant for HEEB in 2008 as the name of a clothing line on the ground that the word is "a highly disparaging reference to Jewish people." *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114, *1 (TTAB 2008). The PTO denied registration in 2008 to MARRIAGE IS FOR FAGS on the ground that "fag" is "an offensive term for a gay man" (serial no. 77477549, office action 11/19/2008), but granted registration in 2005 to F.A.G. FABULOUS AND GAY. Pet.

App. 33a n.7. Applicants have no way to predict what the PTO will do.

The vagueness of the disparagement clause is almost certainly causing business owners to shy away from names the PTO might conceivably find disparaging, because it can be extraordinarily disruptive and costly to change the name of a product that is already in the market. The vagueness of a content-based speech regulation "raises special First Amendment concerns because of its obvious chilling effect on free speech." *Reno v. ACLU*, 521 U.S. at 871-72. The disparagement clause is a perfect example.

Vague speech restrictions do not just chill speech; they also facilitate "discriminatory enforcement," because a "vague law impermissibly delegates basic policy matters" to low-level decision-makers "for resolution on an *ad hoc* and subjective basis, with the attendant dangers of arbitrary and discriminatory application." *Grayned v. City of Rockford*, 408 U.S. 104, 108-09 (1972). The PTO's consideration and rejection of MARRIAGE IS FOR FAGS took place right in the midst of the controversy over California's Proposition 8, which prohibited same-sex marriage. The applicant lived in California. We will never know whether the PTO's examiner was discriminating against the view expressed in the trademark, and that is precisely why vague speech restrictions like the disparagement clause are so pernicious.

CONCLUSION

The petition for a writ of certiorari, with the Questions Presented reformulated as in this response, should be granted.

Respectfully submitted,

STUART BANNER
EUGENE VOLOKH
UCLA School of Law
Supreme Court Clinic
405 Hilgard Ave.
Los Angeles, CA 90095

JOHN C. CONNELL
Counsel of Record
RONALD D. COLEMAN
JOEL G. MACMULL
Archer & Greiner, P.C.
One Centennial Square
P.O. Box 3000
Haddonfield, NJ 08033
(856) 795-2121
jconnell@archerlaw.com